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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,268

11/14/2003

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111325-310200

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22204 7590 02/18/2010

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EXAMINER

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ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

02/18/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT H. TIEU, JOSEPH Z. FUNG, EDDIE J. CHEN,
and BIJAN TADAYON

Appeal 2009-005613
Application 10/712,268
Technology Center 3600

Decided: February 18, 2010

Before MURRIEL E. CRAWFORD, TONI R. SCHEINER, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-3 and 5-40 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE and enter a new grounds of rejection under 35 U.S.C. 112, second paragraph.

THE INVENTION

The Appellants' claimed invention is directed to a system and method for processing rights expressions and for granting access to an item or permission to use an item based on configurable conditions (Spec. [0002]). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A computer-implemented method for processing plural rights expressions associated with an item for use in a system for controlling use of the item in accordance with the rights expressions, the method comprising:

receiving a request to use the item, the item having associated rights expressions governing use of the item;

returning one or more rights expressions including one or more conditions that must be satisfied in order to use the item; and

processing the returned rights expressions in a manner to facilitate selection of the returned rights expressions in order to use the item in accordance with the selected rights expressions, and including:

prioritizing the returned rights expressions based on the one or more conditions of the returned rights expressions, so as to facilitate selection of the returned rights expressions.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Levitt US 2002/0099544 A1 Jul. 25, 2002

The following rejections are before us for review:

1. Claims 1-3 and 5-40 are rejected under 35 U.S.C. § 102(e) as anticipated by Levitt.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Levitt discloses “rights expressions” as claimed in independent claims 1, 37, and 40.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. The Specification at paragraph [0037] states: “A rights expression need not be limited to licenses in particular, but can include any suitable

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

expressions that can be used by the exemplary rights expression processing system 10 to convey information. Thus, a rights expression and derivatives thereof can generally include expressions of licenses, license components and/or fragments thereof, such as the grant element, principal element, right element, resource element, and/or condition element, as well as any other suitable expressions”.

FF2. Levitt is directed to a computer program product for speech recognition (Abstract) and provides for recognizing utterances.

FF3. Levitt at [0011] discloses that grammar expressions may be played back to a user and may be prioritized and outputted based on a score.

FF4. Levitt at [0162] cites to Fig. 5 and discloses a method of recognizing utterances utilizing a database. The utterances may be received by a telephone call.

FF5. Levitt at [0179] discloses that grammar expressions are compared against a database and prioritized. The grammar expressions with the highest priority may then be outputted in operation 514.

FF6. Levitt at [0011], [0162], and [0179] does not disclose information specifically related to a “digital rights” expression system.

FF7. There is no algorithm for a “means for receiving a request to use the item” at Figure 18 and [0135] of the Specification (FF6).

PRINCIPLES OF LAW

Principles of Law Relating Claim Construction

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest

reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

ANALYSIS

The Appellants argue that the rejection of claims 1-3 and 5-40 is improper because Levitt merely relates to a system for speech recognition and does not relate to digital rights management (DRM) (Br. 5, Reply Br. 2). The Appellants argue “The grammar expressions of Levitt are not components of a DRM system, but instead tools used to recognize user utterances” (Br. 6). The Appellants argue that Levitt fails to disclose for instance “processing plural rights expressions associated with an item for use in a system for controlling use of the item in accordance with the rights expression” and “receiving a request to use the item, the item having associated rights expressions governing use of the item” as recited in the claim. (Br. 6).

In contrast the Examiner has determined that the claims are anticipated by Levitt. The Examiner has found that Levitt discloses the above cited claim limitation at paragraphs [0011], [0162], and [0179] (Ans. 4). The Examiner has also determined “that the grammar expressions of Levitt is readable as a plural rights expressions of the Applicants claimed invention” (Ans. 4).

We agree with the Appellants. We begin with claim construction and determine the scope of term “rights expressions” as used in the claims in light of the Specification. The Specification at paragraph [0037] states:

[0037] A rights expression need not be limited to licenses in particular, but can include any suitable expressions that can be used by the exemplary rights expression processing system 10 to convey information. Thus, *a rights expression and derivatives thereof can generally include expressions of licenses, license components and/or fragments thereof, such as the grant element, principal element, right element, resource element, and/or condition element, as well as any other suitable expressions.* (Emphasis added).

Thus giving the term “rights expression” its broadest reasonable interpretation in light of the Specification we construe this term to include licenses, license components, grant elements, principal elements, and other similar type rights expressions. Thus we do not construe the term “rights expression” to refer to tools used to recognize user utterances or grammar expressions. Claim 1 requires “receiving a request to use the item, the item having associated rights expressions governing use of the item” and the Examiner has asserted Levitt as disclosing this limitation at paragraph [0179] (Ans. 4). We have determined that Levitt at paragraph [0179] does not disclose this limitation (FF6) since the grammar expressions are not disclosed to have any “rights expressions” associated with them (FF6). For

these reasons the rejection of claim 1 and its dependent claims are not sustained. Claims 37 and 40 contain a limitation similar to that in claim 1 addressed above and the rejection of these claims and their dependent claims is not sustained also for these same reasons.

NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 37-40 under 35 U.S.C. § 112, second paragraph as being indefinite.

Principles of Law

Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

When no structure is described in the Specification to support a means-plus-function limitation in a claim, the disclosure is inadequate to explain to one of ordinary skill in the art what is meant by the claim language. In such a situation, a means-plus-function claim would not be amenable to construction and thus would fail to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

"[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect

failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc). This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *See O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997). "Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure." *Atmel*, 198 F.3d at 1382. While corresponding structure need not include all things necessary to enable the claimed invention to work, it must include all structure that actually performs the recited function. *See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002).

Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc., 412 F.3d 1291, 1298 (Fed. Cir. 2005).

When the means-plus-function limitation in a claim is a *computer-enabled* means-plus-function limitation, one must set forth in the specification sufficient description of an *algorithm* associated with the function recited in the claim in order to avoid a finding that an applicant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

It is certainly true that the sufficiency of the disclosure of algorithmic structure must be judged in light of what one of ordinary skill in the art would understand the disclosure to impart. *See, e.g., Intel Corp. v. VIA Techs.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003) (knowledge of a person of ordinary skill in the art can be used to make clear how to implement a disclosed algorithm); *Atmel Corp.*, 198 F.3d at 1379 ("[T]he 'one skilled in the art' analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation."). That principle, however, has no application here, because in this case there was no algorithm at all disclosed in the specification. The question thus is not whether the algorithm that was disclosed was described with

sufficient specificity, but whether an algorithm was disclosed at all.

Aristocrat Techs. Australia Party, Ltd. vs. Int'l Game Tech., 521 F.3d 1328, 1337 (Fed. Cir. 2008).

When there is insufficient description of an algorithm in the Specification to support a computer-enabled means-plus-function limitation in a claim, the disclosure will be considered inadequate to explain to one of ordinary skill in the art what is meant by the claim language.

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure. The district court correctly determined that the structure recited in the '505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the

function, as required by section 112 paragraph 6.”). This court does not impose a lofty standard in its indefiniteness cases. *See, e.g., Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1214 (Fed. Cir. 2003). But in this case, the claims are already quite vague. Without any corresponding structure, one of skill simply cannot perceive the bounds of the invention.

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 (Fed. Cir. 2008).

When a Specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. *See also Aristocrat*, 521 F.3d 1328, 1333 (*quoting Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) (“‘[t]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.’ *Harris* 417 F.3d at 1249.”); *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008) (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”). *See also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (Fed. Cir. 2009) (finding Blackboard’s means-plus-function claims indefinite because the patent describes an undefined component, *i.e.*, a black box, that performs the recited function but does not disclose how the component performs the function). *See further Ex parte Catlin*, 90 USPQ2d 1603, 1605 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being

indefinite if a Specification fails to disclose any algorithm corresponding to the recited function in the claims).

Analysis

We reject claims 37-40 under 35 U.S.C. § 112, second paragraph as being indefinite.

We count five limitations in claim 37 which are in means-plus-function format. We will focus on the “means for receiving a request to use the item” limitation. But the analysis to follow applies equally as well to the other means-plus-function limitations in claims 37-40.

The limitation “means for receiving a request to use the item” includes the term “means.” A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999) (“presumed an applicant advisedly used the word “means” to invoke the statutory mandates for means-plus-function clauses.”).

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). Thus, according to the language of claim 11, the function of the “horizontal drive means” is “rotating said lamp unit in a horizontal direction.” Ordinary principles of claim construction govern interpretation of this

claim language, *see id.*, and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Step 1- The first step in construing a means-plus-function claim limitation is to define the particular function in the means-plus-function limitation.

The particular function of the means-plus-function claim limitation at issue is “for receiving a request to use the item.”

Further, given the claim as a whole being directed to a “system for processing plural rights expressions” which we have construed as reasonably broadly involving a computer, one of ordinary skill in the art would construe the claim limitation “means for receiving a request to use the item” to refer to a *computer-enabled* means-plus-function limitation.

Step 2- The next step in construing a means-plus-function claim limitation is to look to the Specification and identify the corresponding structure for that function. Given that the claim limitation “means for receiving a request to use the item” is a *computer-enabled* means-plus-function limitation, this requires looking to the Specification and identifying

the algorithm corresponding to the function “receiving a request to use the item.”

In that regard, we note that in the Summary of Claimed Subject Matter (App. Br. 12), the Appellants have attempted to show where in the Specification, by page and line number, there is disclosed structure, material, or acts corresponding to each claimed function as required by 37 C.F.R. § 41.37(c)(1)(v) (2007). With regard to the claim 37 means-plus-function limitation at issue, the Appellants attempt to show that the disclosed structure is shown at Figure 18 and paragraph [0135]. We find no algorithm to disclose “means for receiving a request to use the item” at Figure 18 and paragraph [0135] (FF7).

The Specification therefore fails to disclose an algorithm corresponding to the recited function at issue (FF7) in claim 37 such that one of ordinary skill in the art could determine the scope of claim 37. Accordingly, we reject claims 37-40 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-3 and 5-40 under 35 U.S.C. § 102(e) as anticipated by Levitt.

We enter a new grounds of rejection under 35 U.S.C. § 112, second paragraph for claims 37-40.

DECISION

The Examiner’s rejection of claims 1-3 and 5-40 is reversed.

We enter a new ground of rejection of claims 37-40 under 35 U.S.C. § 112, second paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

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